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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
09/934,003	08/20/2001	Anthony J. Baerlocher	0112300-722	7783
29159	7590	10/04/2004	EXAMINER	
BELL, BOYD & LLOYD LLC			JONES, SCOTT E	
P. O. BOX 1135			ART UNIT	PAPER NUMBER
CHICAGO, IL 60690-1135			3713	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/934,003	BAERLOCHER ET AL.	
	Examiner	Art Unit	
	Scott E. Jones	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 13, 17-19, 22, 23, 29-32, 34, 37, 38, 42, 44 and 47-50 is/are rejected.
- 7) ☒ Claim(s) 6-11, 14-16, 20, 21, 24-28, 33, 35, 36, 39-41, 43, 45 and 46 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This office action is in response to the amendment filed on May 25, 2004 in which applicant amends the specification, submits a terminal disclaimer, submits an affidavit under 37 C.F.R. 1.131, and responds to the claim rejections. Claims 1-50 are pending.

2. The Affidavit filed on May 25, 2004 under 37 CFR 1.131 is sufficient to overcome the Rose (U.S. 6,589,114) reference.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 12-13, 17-19, 22-23, 29-32, 34, 37-38, 42, 44, and 47-50 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamano (U.S. 5,205,555).

Hamano discloses a gaming machine that determines an award for a player by performing a mathematical computation of the numbers that stop on the top line of reels of a gaming machine. The player may operate stop switches to stop the reels in order to select the numbers obtained on the reels. Hamano discloses:

Regarding Claims 1, 12, 30, 42, and 47-49:

- a display device (Figures 1-4 and 8);

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- a plurality of player selectable positions/masked numbers (the selected payline(s) of reels 1a to 1d) displayed by the display device (Figures 1-4 and 8, Column 3, lines 30-36).
- a processor which communicates with the display device, which enables a player to select the positions, which associates numbers with the positions based on the player's selection of the positions and which determines an award based on an order of the numbers associated with the positions, wherein the award is based on a number of monetary units equal to the order of the numbers associated with the positions (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).
This scenario occurs when a value of 0 is obtained on reels 1a and 1b, and when any number, such as 5, is obtained on reel 1c. For instance, if one credit is wagered by the player and a combination of 0-0-5 is obtained, the player will be awarded 5 credits.

Regarding Claim 2:

- wherein the positions include at least a one's digit, a ten's digit, and a hundred's digit for the award (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). In the example above, 5 is in the one's digit and 0 is in the ten and hundred's digit.

Regarding Claims 3 and 29:

- the award is based on the order of at least three positions, wherein the numbers associated with two of said positions/masked numbers are combined my a

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mathematical operation (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).

Regarding Claims 4 and 35:

- includes an initial sequence controlled by the processor for determining how many positions the player is enabled to select (Column 3, lines 30-36).

Regarding Claims 5, 36, and 50:

- the initial sequence includes a plurality of player selectable inputs and a number of positions associated with each selectable input (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).

Regarding Claim 13:

- the numbers are digits and the award is a number of credits which is the order of the digits (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). This scenario occurs when a value of 0 is obtained on reels 1a and 1b, and when any number, such as 5, is obtained on reel 1c. For instance, if one credit is wagered by the player and a combination of 0-0-5 is obtained, the player will be awarded 5 credits.

Regarding Claim 17:

- includes a set of numbers stored in a memory device accessed by the processor, wherein the processor randomly generates the masked numbers from the set of numbers in the memory device (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).

Regarding Claim 18:

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- each of the numbers of the set are unique (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). This scenario occurs when a value of 0 is obtained on reels 1a and 1b, and when any number, such as 5, is obtained on reel 1c. For instance, if one credit is wagered by the player and a combination of 0-0-5 is obtained, the player will be awarded 5 credits.

Regarding Claim 19:

- at least two of the numbers of the set are the same (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). In the scenario provided above, the zeros in the ten's and hundred's digit are zeros.

Regarding Claims 22 and 37:

- includes a plurality of reels controlled by the processor, wherein said masked numbers are randomly generated by at least one of the reels (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).

Regarding Claims 23 and 38:

- includes a player selectable keep input which communicates with the processor, wherein activation of the keep input by the player causes the processor to transfer the award provided to the player to a credit meter controlled by the processor (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). The player initiating the reel stop feature would accomplish this limitation.

Regarding Claim 31:

- which includes three positions (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36).

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Regarding Claim 32:

- the award includes each of the selections displayed by the display device (Figures 1-4 and 8, Column 1, line 38-Column 2, line 33, and Column 3, lines 30-36). This scenario occurs when a value of 0 is obtained on reels 1a and 1b, and when any number, such as 5, is obtained on reel 1c. For instance, if one credit is wagered by the player and a combination of 0-0-5 is obtained, the player will be awarded 5 credits.

Regarding Claim 34:

- wherein the plurality of positions are displayed by the display device before the player associates the selections with the positions (Figures 1-4 and 8).

Allowable Subject Matter

5. Claims 6-11,14-16,20,21,24-28,33,35,36,39-41,43,45 and 46 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Terminal Disclaimer

6. The terminal disclaimer filed on May 25, 2004 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Application No. 09/933,843 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

7. Applicant's arguments with respect to claims 1-50 have been considered but are moot in view of the new ground(s) of rejection.

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8. Applicant's arguments, see pages 2-4, filed May 25, 2004, with respect to the objections to the specification have been fully considered and are persuasive. The objection of the specification have been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on (703) 308-2064. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott E. Jones
Examiner
Art Unit 3713

sej

